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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH L. DAVIS

Appeal 2007-3011
Application 09/862,884¹
Technology Center 2100

Decided: March 19, 2008

Before: LANCE LEONARD BARRY, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals from a final rejection of claims 1 to 24 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

¹ Application filed May 21, 2001. The real party in interest is Autodesk, Inc.

Appellant's invention relates to a method, apparatus and computer program (method) for annotating a video comprising a series of frames. At a certain frame, the video pauses and displays an annotation on the frame. When the user elects to proceed, the video continues. In the words of the Appellant:

Annotation information is obtained from a user or application that specifies an annotation, the frame to be annotated, and the location on the frame where the annotation is to be displayed. A sequence of frames such as a video clip or animation is then displayed. When the indicated frame is displayed, the display process is paused and the annotation is displayed/overlaid on the frame at the location specified.

(Spec.: 3).

Claim 1 is exemplary:

1. A computer-implemented method for annotating, comprising:
 - (a) obtaining a sequence of frames to be consecutively displayed on a display device, wherein a frame comprises one or more images;
 - (b) obtaining annotation information, wherein the annotation information comprises:
 - (i) an identification of an identified frame within the sequence of frames;
 - (ii) an annotation, and
 - (iii) a location on the identified frame to display the annotation;
 - (c) consecutively displaying one or more of the sequence of frames;

(d) determining when the identified frame is displayed and automatically pausing the display of the sequence of frames at the identified frame;

(e) displaying the annotation at the location on the identified frame while the display is paused; and

(f) continue displaying the sequence of frames subsequent to the identified frame when a user elects to proceed.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Russell, Jr.	5,526,478	Jun. 11, 1996
Wistendahl	5,708,845	Jan. 13, 1998
Gupta	6,484,156	Nov. 19, 2002

Rejections:

R1: Claims 1 to 6, 8 to 14, 16 to 22 and 24 stand rejected under 35 U.S.C. § 103(a) for being obvious over Wistendahl in view of Russell.

R2: Claims 7, 15 and 23 stand rejected under 35 U.S.C. § 103(a) for being obvious over Wistendahl in view of Russell in further view of Gupta.

Appellant contends that the claimed subject matter is not anticipated by Wistendahl in combination with Russell and Gupta, for failure of the references to teach claimed features. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this opinion. Arguments which Appellant could have made but chose not to

make in the Briefs have not been considered and are deemed to be waived.
See 37 C.F.R. § 41.37(c)(1)(vii) (2004).²

We affirm the rejections.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether the references teach the claimed automatic pausing of the display of a sequence of frames at an identified frame, the display of an annotation when paused, and the continuing of the display of the sequence of frames when the user elects to proceed, as claimed.

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

² Appellant has not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

References within the statutory terms of 35 U.S.C. § 103 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); *see also In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

From our review of the administrative record, we find that Examiner has presented a prima facie case for the rejections of Appellant's claims under 35 U.S.C. § 103. The prima facie case is presented on pages 3 to 10 of the Answer.

In opposition, Appellant presents three main arguments summarized on page 7 of the Brief, discussed on the following pages, and in the Reply Brief.

The first argument contends that the references Wistendahl, Russell and Gupta do not teach, disclose or suggest automatically pausing a display of a sequence of frames at a particular identified frame. The Wistendahl patent teaches adding to media content (video), which may be encoded as a series of successive display frames, object mapping data keyed to specific locations on certain of the frames. (Col. 2, line 45+). This object mapping data, called N Data in the Wistendahl patent, maps to hot spots on certain frames. (Col. 5, line 57). For example, the video may be the movie "The Maltese Falcon," per an example in the patent, and when the user gets to the point in the movie where the Maltese falcon is shown, the N Data can display a pop-up window on the screen, and indicate that a replica of the statue can be purchased at a certain site on the World Wide Web. (Col. 8, line 64). When the user clicks on that object, the system will pause the movie to allow time for the user to consider the offer. (Col. 9, line 7). By clicking on the remote control pointer 36 on a displayed "Save" button, the user of the Wistendahl patent continues the program, storing the data about the replica statue. (Col. 9, lines 11-14). Appellant argues that this pausing of the movie is not "automatic" as claimed. (Brief, page 9, top). Examiner

argues that the claim does not recite “without human intervention” but only “automatically pausing the display.” (Answer, page 5). Effectively, the Examiner argues that the Wistendahl reference teaches programming a system to display a pop-up window at a particular frame, and permit a clicking of a portion of the display to pause the movie. It would be an obvious variation of this teaching to program a pause in the display to allow the user more time to consider the N Data in the pop-up, i.e. the statue offer. The motivation for this change is right in Wistendahl, where he indicates, “to pause the running of the movie to allow time for the user to absorb the IDM program response.” (Col. 9, l. 7).

We do not see error in the Examiner’s reasoning. “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1732 (2007). We find that in view of the teachings of Wistendahl as expressed above and explained in the Answer (pages 13+), we cannot support Appellant’s argument.

Appellant further argues that the references do not teach displaying an annotation at a defined location on the identified frame when the sequence has been paused. (Brief, page 7, top). In view of Wistendahl’s teaching that the movie display can be paused, column 9, line 7, and his demonstration of an annotation at a defined location (e.g. around the airplane in Figure 2), we find no support for this argument.

Thirdly, Appellant contends that the references do not teach, disclose, or suggest continuing the display of the sequence of frames when the user selects to proceed. (Brief, page 7, top). Wistendahl indicates, “Alternatively, the user may wish to bypass the response [to the annotation, in the form of a message] and store it to be reviewed after the movie is finished. By input from the remote control pointer **36 ...**”. (Col. 9, lines 8-11). This section of the Wistendahl patent suggests to us that the display of the sequence of frames is continued when the user elects to proceed, as claimed.

As Wistendahl and Russell are both concerned with annotations on video displays, a common field of endeavor, we consider them from analogous arts, and properly combinable. *See In re Deminski*, cited above.

Rejection of claims 7, 15 and 23 for being obvious over Wistendahl in view of Russell in further view of Gupta.

Appellant argues that the teachings of Gupta are general in nature, and not related to the annotation of a video sequence of frames. (Brief, page 12, bottom). Examiner has expressed how Gupta teaches the annotations being in XML (Answer, page 17, bottom). Added to the reasoning concerning Wistendahl and Russell expressed above, we do not find support for the Appellant’s contention.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 24.

DECISION

The Examiner's rejection of claims 1 to 24 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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